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EXAMINER

PALO, FRANCIS T

ART UNIT PAPER NUMBER

3644

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,173

Applicant(s)

ALCAZAR, ANTONIO V.

Examiner

Francis T. Palo

Art Unit

3644

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-153 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 13, 15, 20-22, 27, 28, 51-53, 64, 66, 71-73, 78, 79, 104, 105, 118, 123-125, 130 and 131 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/15/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3,4,6-12,14,16-19,23-26,29-50,54-63,65,67-70,74-77,80-102,106-117,119-122,126-129 and 132-153.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group-I, Species A1 and B1 (claims **1**, **2**, **5**, **13**, **15**, **20-22**, **27**, **28**, **51-53**, **64**, **66**, **71-73**, **78**, **79**, **104**, **105**, **118**, **123-125**, **130** and **131** in the reply filed on 3/15/04 is acknowledged.

Claims **3-4**, **6-12**, **14**, **16-19**, **23-26**, **29-50**, **54-63**, **65**, **67-70**, **74-77**, **80-101**, **102**, **103**, **106-117**, **119-122**, **126-129** and **132-153** are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 3/15/04.

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Applicant remarks that independent claims 1 and 51 appear to be generic; the Examiner responds that of the three elected independent claims 1, 51 and 104, independent claim-1 is generic to independent claim-104 and independent claim-51 contains the mutually exclusive features of "thermosetting material" and "flexible shape-sustaining sidewall".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 51-53, and 104-105 are rejected under 35 U.S.C. 102(b) as being anticipated by Goertz (EP 412317) 1991.

Regarding **claim-1**:

Goertz discloses **a plastic flower-pot cover** (shape sustaining) configured and sized to encompass and surround a flower pot as cited in the instant claim; wherein a base portion as cited is evident from the Figures and Abstract ("shape of a champagne bucket"; buckets having bottoms).

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The base portion of Goertz is readable as formed from a thermal forming process as cited, as thermal forming would be an inherency of the **plastic** consisting device of Goertz.

Goertz further discloses in the Abstract the plastic cover to be provided with a metallized surface (read as; having decorative ornamentation associated with the outer surface); the sidewall outer surface of the Goertz cover is also devoid of any folds as cited in the instant claim.

Regarding **independent claim-51**:

The discussion above regarding independent claim-1 is relied upon.

The instant invention of claim-51 differs from the device of independent claim-1 in that the device of claim-51 is formed of a thermosetting material and the sidewall is further limited to being flexible and shape sustaining.

The cover of Goertz being made of plastic is capable of being formed by a thermosetting material, and it is the Examiner's position that thermoforming or thermosetting fabrication are not patentable features in the arts of pots and covers.

Regarding **independent claim-104**:

The discussion above regarding independent claim-1 is relied upon.

Independent claim-1 is generic to independent claim-104; claim-104 differs from claim-1 in that the base portion is shaped and sized so as to substantially encompass and surround at least a portion of an outer surface of a flower pot, whereas claim-1 cites substantially encompassing and surrounding an outer surface of a flower pot.

As claim-1 encompasses and is broader than the device of claim-104, the discussion above regarding independent claim-1 is relied upon and not repeated herein for the rejection of claim-104.

Regarding **repeating dependent claims 2, 53 and 105**:

The discussions above regarding the independent claims 1, 51 and 104 are relied upon. Goertz discloses **a plastic flower-pot cover** (shape sustaining) configured and sized to encompass a flower pot as cited in the instant claim; wherein a base portion as cited is evident from the Figures and Abstract ("shape of a champagne bucket"; buckets having bottoms).

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Regarding **claim-52**:

The discussions above regarding independent claims 1 and 51 are relied upon.

As discussed above in the independent claims, the plastic device of Goertz is capable of being formed by the processes of the instant claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 13 and 64 are rejected under 35 U.S.C. 103(a),
as being unpatentable over Goertz (EP 412317) 1991.

Regarding **repeating dependent claims 5, 13 and 64**:

The discussions above regarding independent claims 1 and 51 are relied upon.

Goertz discloses ornamentation (metallized surface) associated with the outer surface of the cover sidewall.

The Examiner has stated previously that the decorative ornamentation of the outer surface of containers and pot covers is not a patentable feature.

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In the absence of any stated problems solved by or any stated advantage obtained by having a certain feature as claimed in the instant invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have decorated the outside sidewall of Goertz as cited in the instant claims, as further such modification is merely an alternate equivalent ornamentation means performing the same intended function of decorating the outside of a container for aesthetic appeal.

Claims 15, 22, 66, 73, 118 and 125 are rejected under 35 U.S.C. 103(a), as being unpatentable over Goertz (EP 412317) 1991 in view of Avot (US 6,161,332).

Regarding **repeating dependent claims 15, 22, 66, 73, 118 and 125**:

The discussions above regarding the independent claims are relied upon.

Goertz does not depict a skirt portion extending from the sidewall of the base portion as cited in the instant claims; furthermore, the Applicant cites in the independent claims, a base portion shaped and sized to substantially encompassing the flower pot, and this broad limitation affords the reading that any portion of the cover extending above the pot contained within the cover, is considered as a skirt portion.

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Avot '332 teaches a base portion (31) substantially encompassing a flower pot (35), and having a removable skirt portion (34) positioned about the base portion and extending a distance from the base portion as cited.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the cover of Goertz to include a skirt portion (34) as taught by Avot (extending from the sidewall of the base portion), for the well known advantages of that feature; specifically, as a protective feature for the plant foliage extending from the pot residing within the cover.

Claims 20, 27, 71, 78, 123 and 130 are rejected under 35 U.S.C. 103(a), as being unpatentable over Goertz (EP'317) and Avot (US '332) as applied to claims 15, 22, 66, 73, 118 and 125 above, and further in view of Morley (US 2,138,188) 1937.

Regarding **repeating dependent claims 20, 27, 71, 78, 123 and 130**:

The discussions above regarding claims 15, 22, 66, 73, 118 and 125 are relied upon. Goertz as modified by the skirt teaching of Avot, is silent as to the skirt extending from at least a portion of the sidewall positioned between the inner surface and the outer surface of the sidewall.

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Morley '188 teaches a device (1) capable of use as a pot cover in Figures 1 and 4, and further depicts a domed upper cover readable as a skirt; said skirt extending from the region depicted by element numbers 2-5, which read on "extending from at least a portion of the sidewall positioned between the inner surface and the outer surface of the sidewall", as cited in the instant claims.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have further modified the cover of Goertz to include the skirt extending as cited in the instant claims, as in the absence of any stated problems solved by or any stated advantage obtained by having a certain feature as claimed in the instant invention, further such modification is merely an alternate equivalent attachment means performing the same intended function of fixing an extension to a container.

Claims 21, 28, 72, 79, 124, and 131 are rejected under 35 U.S.C. 103(a), as being unpatentable over Goertz (EP'317) and Avot (US '332) as applied to claims 15, 22, 66, 73, 118 and 125 above, and further in view of Morley (US 2,138,188) 1937.

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Regarding **repeating dependent claims 21, 28, 72, 79, 124, and 131:**

The discussion above regarding claims 15, 22, 66, 73, 118 and 125 is relied upon; Likewise, the rejection of the previously discussed claims 20, 27, 71, 78, 123 and 130 is relied upon and repeated, as "a skirt connected" as cited in the instant claims is read as being equivalent to "a skirt extends" as cited in the instant claims discussed in the preceding rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims (independent) 1, 51 and 104 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of U.S. Patent No. 6,474,020, and over claims 1 and 6 of U.S. Patent No. 6,234,786 . Although the conflicting claims are not identical, they are not patentably distinct from each other because the flower pot covers of the instant invention are encompassed by the flower pot covers of the conflicting Patents.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lynch '142 (1874) teaches a shape sustaining pot cover having decorative ornamentation associated with the outer surface of the cover sidewall.

Raymond D'448 teaches decorative ornamentation.

Albertson '106 teaches a flowerpot cover with a skirt.

Reynolds '263 teaches a pot cover having a base, sidewalls and a skirt, the skirt attached around the inside of the sidewall.

Guarriello '963 teaches blow and injection molding.

Berlit EP'108 teaches thermoplastic deep drawing forming process.

Ostkotte DE'435 teaches bas-relief ornamentation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 703-305-5595. The examiner can normally be reached on T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Carone can be reached on 703-306-4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Francis T. Palo

Francis T. Palo
Examiner
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